

REMARKS

In the Office Action, the drawings were objected to under 37 CFR 1.83 (a). Claim 10 was objected to because of informalities. Claims 10-20 were rejected under 35 U.S.C. § 112, first and second paragraphs. Claims 10, 12-15 and 19 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 6,485,520 to Hubach et al. ("Hubach") in view of U.S. Patent No. 6,746,486 to Shultz et al. ("Shultz"). Claims 10-13, 17, 18 and 20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 6,312,471 to Kubein-Meesenburg et al. ("Kubein") in view of U.S. Publication No. 2003/0153982 to Pria ("Pria"). Claim 16 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kubein in view of Pria and further in view of U.S. Patent No. 5,009,665 to Serbousek et al. ("Serbousek").

In this response, paragraphs [0010] and [0020] have been amended. Claims 10-12, 15 and 16 have been amended. Claims 14 and 20 have been cancelled. Upon entry of the amendments, claims 10-13 and 15-19 will be pending.

Reconsideration of the application based on the following remarks is respectfully requested.

Amendments to the specification

Applicants have amended the specification to provide a different translation of the German word "Verzahnung," as used in the original priority document, which is in German. "Teeth" has been replaced with "cogging", which is a translation of the word "Verzahnung." Applicants respectfully submit that, because "cogging" is a translation of the word used both in the originally filed German Application and in the originally filed PCT Application, no new matter has been added.

Objection to the drawings

The drawings were objected to under 37 CFR 1.83 (a).

Applicants respectfully submit that claim 10 has been amended to recite that a first functional surface of the joint socket is non-spherical in shape, has orbital radii that differ from each other in a main functional plane relative to a secondary functional plane rotated by 90° with respect to the main functional plane, and is affixable in different positions relative to the joint socket. Applicants respectfully submit that, with the amendments to claim 10 and its dependent claims, the drawings show every feature of the invention specified in the claims, and therefore withdrawal of the objection is respectfully requested.

Objection to claim 10

Claim 10 was objected to because of informalities.

Claim 10 has been amended to remove “including” following “having”, thus correcting the informality. Withdrawal of the objection to claim 10 is respectfully requested.

Rejections to claims 10-20 under 35 U.S.C. § 112, first paragraph

Claims 10-20 were rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for a socket having an asymmetrical functional surface, does not reasonably provide enablement for a condyle having an asymmetrical functional surface.

With respect to claims 10 and 11, claim 10 has been amended to recite that the first functional surface of the joint socket is affixable in different positions relative to the joint socket. Claim 11 has been amended to recite that the first functional surface displays an asymmetry. Therefore, claims 10 and 11 are enabled by the specification.

Claim 10 has been amended to recite that the condyle has a second functional surface, and that the joint socket has a first functional surface. Support for the amendment is found, for example, in paragraph [0008], of the originally filed specification. Applicants respectfully submit that, as a result of the amendment, claim 13 is enabled by the specification.

Therefore, withdrawal of the rejections under 35 U.S.C. § 112, first paragraph, are respectfully requested.

Rejections to claims 10-20 under 35 U.S.C. § 112, second paragraph

Claims 10-20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended claim 10 to be consistent with the specification, wherein the joint socket has an inlay with a first functional surface, and wherein the condyle includes a second functional surface.

Applicants have further amended claim 10 to recite that the first functional surface has orbital radii that differ from each other in a main functional plane relative to a secondary functional plane rotated by 90° with respect to the main functional plane, and applicants have amended claim 11 to recite that the first functional surface displays an asymmetry.

Therefore, withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, are respectfully requested.

Rejection under 35 U.S.C. § 103 (a) in view of Hubach and Schultz

Claims 10, 12-15 and 19 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hubach in view of Shultz.

Huback describes a wrist prosthesis having distal and proximal sections, which are connected with one another by a curved bearing. *See* Huback, Abstract.

Shultz describes a prosthetic wrist having a radial insert. *See* Shultz, Abstract.

Claim 10 has been amended to include the feature of claim 20, wherein the joint is a human hip replacement joint.

Applicants respectfully submit that neither Shultz nor Huback teach or suggest a hip joint as recited in independent claim 10. Both references are directed towards a wrist joint, which is not anatomically synonymous with a hip joint. Furthermore, because the feature of claim 20, which was not rejected as obvious in view of Shultz and Hubach, is now included in claim 10, applicants respectfully submit that the obviousness rejection has been obviated and withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 103 (a) in view of Kubein and Pria

Claims 10-13, 17, 18 and 20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kubein in view of Pria.

Kubein describes an artificial condyle for use in a human hip joint in which the condyle has a spherical joint shell. *See* Kubein, Abstract.

Pria describes an acetabular prosthesis of a hip having at least an outer shell insertable and fixable in a relative bone seating. *See* Pria, abstract. According to Pria, the insert can be positioned in two selectable positions through a rotation of 180° so as to position the insert in a pre-determined variation. *See* Pria, paragraph [0023].

The Examiner admits that Kubein does not teach the feature wherein the functional surface is affixable in different positions relative to the joint socket, and the Examiner uses the teachings of paragraph [0006] of Pria to cure the deficiency, wherein an angle of an articular insert can be modified. *See* Office Action, p. 7, lines 9-12. Applicants have now amended claim 10 to include the feature of a cogging formed between the socket part and the inlay, wherein different positions of the first functional surface correspond to different locking stages formed by the cogging. Support is found, for example, in original claim 14 and amended paragraph [0020], and in feature 8 of Fig. 3. Amendments to paragraph [0020] are supported by the originally filed German Application.

Applicants respectfully submit that Pria does not teach the feature wherein different positions of the first functional surface correspond to different locking stages formed by the cogging. On the contrary, Pria merely describes two selectable positions offset by 180°. *See* Pria, paragraph [0028]. The two selectable positions allow an adjustable angle of cover from one angle to another, but Pria fails to teach that different positions of the first functional surface 5 correspond to different locking stages 8 formed by the cogging between the socket and the inlay. *See* Pria, paragraph [0065] and Fig. 3 of the current application.

Because neither Kubein nor Pria suggests the features of claim 10 and its dependent claims, withdrawal of the rejections under 35 U.S.C. § 103 (a) is respectfully requested.

CONCLUSIONS

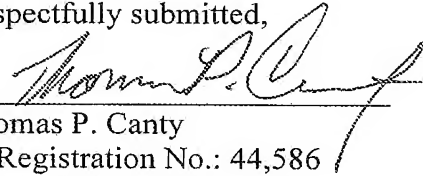
In view of the above amendment, applicant believes the pending application is in condition for allowance.

The Commissioner is hereby authorized to charge any unpaid fees deemed required in connection with this submission, including any additional filing or application processing fees required under 37 C.F.R. §1.16 or 1.17, or to credit any overpayment, to Deposit Account No. 04-0100.

Dated: March 18, 2010

Respectfully submitted,

By



Thomas P. Canty

Registration No.: 44,586

DARBY & DARBY P.C.

P.O. Box 770

Church Street Station

New York, New York 10008-0770

(212) 527-7700

(212) 527-7701 (Fax)

Attorneys/Agents For Applicant